IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Gleave, et al.	
Application No.: 10/646,436	
Filed: 8/21/2003	Group Art Unit: 1635
Title: RNAi Probes Targeting Cancer-Related Proteins	Examiner: Kimberly Chong
	Confirmation No. 9171
Attorney Docket No.: UBC.P-030	

REPLY BRIEF FOR APPELLANT

This Reply Brief is filed in support of Applicants' Appeal from the final rejection mailed 1/9/2006, and in response to the Examiner's Answer mailed March 2, 2007.

As a first matter it is noted that in Section (8) of the Examiner's Answer, reference is made to US Patent No. 5,989,031 allegedly of Crooke et al. This patent number is in error since the patent number as stated is for an "Artificial Tooth." On Page 6 of the Examiner's Answer, US Patent No. 5,898,031 is referred to, and it is understood that this is the patent number that was intended to be cited in Section (8) of the Examiner's Answer.

Applicants further note that this reference does not appear to have been previously cited in the prosecution of this application. Citation of new references in the Examiner's Answer is clearly inappropriate, and Applicants request that this portion of the Examiner's Answer be stricken.

Substantively, the issue presented in this case is whether the mere mention of the possibility of making RNA molecules that inhibit expression of clusterin, without the disclosure of even one actual example is an enabling disclosure sufficient to support an anticipation rejection.

In the Examiner's Answer, the Examiner cknowledges that "it is true that Monia et al. do not teach an actual RNA sequence." (page 5). The Examiner then offers the wholly

unsupported statement that "it is routine in the art to make and use RNA oligonucleotides to target and inhibit gene expression." While Applicants agree that the use of RNA oligonucleotides has been disclosed for other targets, this alone is insufficient to make the use of RNA oligonucleotides to a particular target (in this case clusterin) "routine" or to enable the making of the invention without undue experimentation.

Furthermore, the Examiner's arguments based on case law plainly miss the point. Both of the cited cases address the issue of whether or not utility must be disclosed in order for a reference to be anticipatory. This is irrelevant here because Applicants do not challenge enablement on the basis of utility. Indeed, the Monia reference clearly provides a utility for oligonucleotides that inhibit clusterin. What it fails to do is to teach or enable even one RNA oligonucleotide that accomplishes this purpose.

Monia et al. teaches the "idea" that RNA oligonucleotides might be used to inhibit clusterin expression, but it does not enable the practice of this idea. The Examiner has provided neither evidence nor arguments to the contrary, but has instead chosen to mischaracterize Applicants' arguments in order to fit them to inapposite case law.

In view of the foregoing, and the arguments in the Appeal Brief, Applicants submit that the anticipation rejection of claims 1-3 and 10-13 should be reversed.

Respectfully submitted,

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